

**REMARKS**

Claims 1-18 are all the claims pending in the application.

***Statement of Substance of Interview***

As an initial matter, Applicants thank the Examiner for the courtesies extended during the interview conducted on February 12, 2008. During the interview, Applicants' representative requested clarification on the status of claims 7 and 8, which are indicated as being rejected in the Office Action summary, but are not addressed in the Office Action.

The Examiner indicated that claims 7 and 8 contain allowable subject matter, and would be allowable if rewritten in independent form. The interview summary dated February 22, 2008 indicates the same.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

***Allowable Subject Matter***

As noted above, the Examiner indicates that claims 7 and 8 contain allowable subject matter, and would be allowable if rewritten in independent form. Applicants respectfully request the Examiner to hold such rewriting of claims 7 and 8 in abeyance until the Examiner has had an opportunity to reconsider and withdraw the prior art rejection of the other claims, as discussed in further detail below.

***Claim Rejections – 35 U.S.C. § 102***

Claims 1, 3-5, 9, 10, and 15-18 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Publication No. 2003/0031469 to Hirai<sup>1</sup>. For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants submit that claim 1 is not anticipated by Hirai. For example, claim 1 relates a digital camera. The digital camera comprises, *inter alia*, marking instruction means for instructing addition of marking data to an arbitrary frame in recording said motion picture data onto said recording medium, marking means for adding marking data to a frame specified by said marking instruction means, and search means for detecting a frame where said marking data is added while reading motion picture data from said recording medium.

The Examiner contends that Hirai's FIGS. 1 and 2, along with paragraphs [0030], [0037], and [0041]-[0045] disclose these features. Applicants respectfully disagree and submit that the teachings of Hirai are being misinterpreted in the Office Action.

For instance, Hirai is directed to introducing a second moving picture mode in a video recording/playback device for obtaining high quality still pictures (Hirai, paragraph [0026]). Hirai discloses that in the second moving picture mode (also called a portrait mode in Hirai), the number of frames per second (fps) is made smaller and the number of bits per frame is made larger, relative to the first moving picture mode (Hirai, paragraph [0028]).

Hirai sets forth operations of its video recording/playback device in paragraphs [0035]-[0044]. Specifically, Hirai discloses that the video signal photographed with the video camera 1 when a recording switch 11 is operated is digitized and compressed in a video compression

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<sup>1</sup> Applicants point out that the rejection of claim 15 under 35 U.S.C. § 102 is improper. Claim 15 depends from claim 14, which is rejected under 35 U.S.C. § 103.

circuit 3. Here, when a shutter 12 is operated, “a still picture of an intraframe at the moment being compressed by the MPEG-11 format is held in the video compression circuit 3” (Hirai, paragraph [0036]).

If the portrait switch 13 is also operated when the shutter 12 is operated, the second moving picture mode is active (Hirai, paragraph [0037]). In this mode, the frame speed is lowered to 5 fps and the held still picture and subsequent frames are compressed for a predetermined period of time. In addition, at this time, the status of the portrait mode switch is recorded on a sub-code. *Id.*

This “sub-code” is not part of any frame, let alone part of a frame specified by the shutter button 12. Rather, the sub-code is separate from the still picture being compressed when the shutter 12 is operated. For example, referring to its playback operations, Hirai discloses that after decoding a playback signal based on images recorded on the recording medium 8, the signal is converted to a continuous bit stream in a memory 22. Here, the continuous bit stream is “divided into a video signal, an audio signal, a sub-code, etc...” (Hirai, paragraph [0041]). The video signal inherently includes the frames recorded on the recording medium 8. The portrait mode is detected based on the “separated sub-code”, i.e., separated from this video signal (Hirai, paragraph [0042]).

On the other hand, claim 1 recites that the marking instruction means adds marking data to a frame specified by said marking instruction means. Since the sub-code disclosed in Hirai is separate from the video signal, Hirai does not disclose adding marking data to a still picture specified by the operation of the shutter 12. Further, it follows that Hirai also does not disclose the claimed search means for detecting a frame where said marking data is added because the portrait mode in Hirai is detected based on the sub-code.

In view of the foregoing, Applicants respectfully submit that claim 1 is not anticipated by Hirai. Accordingly, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 102(e) rejection of claim 1.

Claims 3-5, 9, 10, and 15-17 are patentable *at least* by virtue of their dependency.

Claim 18 recites features similar to those discussed above with respect to claim 1. Therefore, claim 18 is patentable for reasons similar to, but not necessarily coextensive with, those given above with respect to claim 1.

***Claim Rejections – 35 U.S.C. § 103***

Claims 2 and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirai. Claims 2 and 14 depend from claim 1. Since it has been shown above that Hirai does not disclose each and every feature of claim 1, claims 2 and 14 are patentable *at least* by virtue of their dependency.

Claims 6 and 11-13 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirai in view of U.S. Publication No. 2005/0231631 to Miyazaki. Claims 6 and 11-13 depend from claim 1. Since Miyazaki does not cure the deficient teachings of Hirai with respect to claim 1, claims 6 and 11-13 are patentable *at least* by virtue of their dependency.

***Conclusion***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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**65565**

CUSTOMER NUMBER

Date: April 25, 2008